

REMARKS

Status of the claims

Upon entry of these remarks, claims 1, 22, 23, 25 to 28, 31, 33, 34, 36 and 38 to 75 will be pending in this application. Claims 2 to 21, 24, 29, 30, 32, 35 and 37 were cancelled previously.

Claims 31, 36 and 38 have been rewritten in independent form and amended. Claims 64-75 have been added. Support for the new and/or amended claims may be found throughout the specification as filed, for example in the disclosure on pages paragraphs [0172]-[0298] and paragraphs [0075]-[0086]. No new matter has been added by way of amendment, and Applicants respectfully request entry of these amendments.

Provisional Election

The Examiner has required restriction of the claims into one of three groups - Group V, represented by claims 26, 33 and 34, drawn to a method of treating an immunodeficiency comprising administering an antibody that binds to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:2; Group VIII, represented by claims 31, 36 and 38 drawn to a method of treating an autoimmune disease comprising administering an antibody that binds to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:2; and Group IX, represented by claims 39-63 drawn to a method of killing a cell that that expresses TR17 polypeptide on its surface by administering an antibody to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:2, wherein said antibody is conjugated to a toxin.

The Examiner has instructed that if Group V or VIII is elected, a species election of one of the members of the Markush group in claims 26 or 31, respectively, must be made.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the subject matter of Group VIII and the species of Sjogren's Syndrome corresponding to originally filed Markush member (d) of claim 31 (now Markush member (b) as amended herein). Applicants reserve the right to file one or more divisional applications directed to the non-elected groups and species.

Applicants respectfully traverse the restriction requirement into Groups V, VIII and IX. The Examiner contends that

[i]nventions V, VIII and IX are independent and distinct, each from the other because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals. See Paper No. 5, page 2, lines 18-22.

Applicants respectfully disagree.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a “serious burden.” See M.P.E.P. § 803. In the present situation, no such showing has been made. Indeed, no arguments have been made explaining why it would impose an undue burden to examine the claims of Groups V, VIII and IX together. Contrary to the Examiner's assertion, all the methods in Groups V, VIII and IX comprise the same process step of administering an anti-TR17 antibody of the invention to an individual. Applicants submit that a search of the anti-TR17 antibody used in each of these methods would clearly provide useful information for all three groups. Indeed, this single search may be sufficient to permit examination of each of these three groups. Applicants submit that it would not be a serious burden to examine all the claims of Groups V, VIII and IX together.

Additionally, Applicants note that that required election of species from claim 31 is an election of species within a Markush-type claim. In view of this, Applicants wish to

draw the Examiner's attention to MPEP § 803.02 which instructs that, after election of a species in a Markush type claim,

[t]he Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species....should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended....The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim.

MPEP § 803.02 indicates that should the elected species of the Markush group be found allowable, that examination of will be extended until at least one member of the Markush group is found not to be allowable or, alternatively, until all the members of the Markush group (and thus the entire Markush claim) are determined to be allowable. Thus, restriction of individual members of the Markush group does not result in withdrawal of the non-elected species from consideration by the Examiner unless at least one member of the Markush group is found not to be allowable over the prior art, and no rectifying amendment or convincing argument is made by the Applicant in response. Applicants submit that search of the restricted species together would not be an undue burden (see section (3) below) and that withdrawal of the restriction requirement, at the very least insofar as it applies to the species election, would simplify and expedite examination of the present application.

Applicants respectfully request that the present restriction requirement be withdrawn upon consideration of the above arguments and in view of M.P.E.P. § 803.

Conclusion

In view of the foregoing remarks, Applicants believe that this application is now in condition for substantive examination. The Examiner is invited to call the undersigned at the phone number provided below if any further action by applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Enclosures
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